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09/648,314	08/25/2000	Andrej Gregov	SEAZN.238A	6403
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EXAMINER				
LEROUX, ETIENNE PIERRE				
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/648,314
Filing Date: August 25, 2000
Appellant(s): GREGOV ET AL.

Mauricio A. Uribe

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11/22/2010 appealing from the Office action mailed 7/15/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

15, 16, 27-35 and 40-51

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except

for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

None.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The Board of Patent Appeals and Interferences provided Decision on Appeal on April 20, 2010. Included in the Decision on Appeal was New Ground of Rejection under 35 U.S.C. § 112, first paragraph (written description). New grounds of rejection of claims 15-16, 27-35 and 40-51 was entered under 35 U.S.C. § 112, first paragraph, because the claim limitation "the generated list does not contain the selected seed items" recited in independent claims has not met the written description requirement under 35 U.S.C. § 112, first paragraph.

Applicant Argues:

Applicant quotes the following section from the specification.

In Figure 6, this list of seed items only includes one seed item, item 691 corresponding to item 550 shown in Figure 5. Figure 6 also shows a list of recommended items 610, 620, 630, 640 and

650. These recommended items are based upon using seed item 691 alone as a seed for the recommendation engine.

Furthermore, applicant enters the following argument.

In accordance with the embodiment illustrated in Figure 6, a single seed item 691 is utilized to generate a set of recommendations 610, 620, 630, 640 and 650. Moreover, and as illustrated in Figure 6 (below), none of the recommended items 610, 620, 630, 640 and 650 correspond to the seed item, item 691. Therefore, Figure 6 and its corresponding description clearly convey applicant's possession of the recited limitation "wherein the generated list does not contain the selected seed items."

Examiner Responds:

Examiner is not persuaded. Figure 5 shows a generated list of recommended items for digital photography. The generated list includes The Art of Digital Photography, by Tom Ang, item 550. Figure 6, shows a seed item 691 which is The Art of Digital Photography, by Tom Ang. Clearly the written description contradicts the claim limitation "wherein the generated list does not include the selected seed item" because the generated list of recommended items of Figure 5 includes the seed item 691 of Figure 6.

Furthermore, the written description has the following instances where a list of recommended items includes a seed item in contradiction (emphasis added) to the claim limitation "wherein the generated list does not contain the selected seed items."

The Complete Idiot's Guide to Digital Photography, by Steve Greenberg, Paperback

- (1) Seed Item 411 per Figure 4.
- (2) Recommended item 510, Figure 5
- (3) Recommended item 650, Figure 6

Digital Camera Solutions, Gregory Georges, Paperback

- (1) Seed Item 412, Figure 4
- (2) Recommended Item 540, Figure 5

Real World Digital Photography Industrial Strength Techniques, by Duke McClelland, Katrin Eismann, Paperback

- (1) Seed Item 413, Figure 4
- (2) Recommended item 520, Figure 5
- (3) Recommended item 620, Figure 6

The New Media Guide to Creative Photography, Image Capture and Printing in the Digital Age, by John Carucci.

- (1) Recommended item 630, Figure 6
- (2) Seed item 631, Figure 6

Clearly, the written description included in the specification contradicts (emphasis added) “generating a list of recommended items each based on the selected seed items, wherein the generated list does not contain the selected seed items” because five books are simultaneously a seed item and a recommended item.

(10) Response to Argument

Background:

Claim 15 was amended as below on 8/10/2006.

15. (Currently Amended) A method in a computing system for generating item recommendations for a user, comprising:

receiving requests from the user to display information about each of a plurality of items;

selecting as seed items the plurality of items that were displayed;

generating a list of recommended items each based on the selected seed items, wherein the generated list does not contain the selected seed items; and

displaying the generated list of recommended items to the user.

Appellant Argues:

Appellant argues that examiner has failed to prove that the written description per the specification does not support the limitation “wherein the generated list does not contain the selected seed items.”

Examiner Responds:

Examiner is not persuaded for the reasons given below.

Specification page 6, paragraph 4 states:

Figure 4 is a display diagram showing sample search results. It can be seen that the search has produced a number of items, including book items 411-413, that are the most relevant to the search string inputted as shown in Figure 3. The search results are preferably accompanied by a recommendations button 420. The user preferably clicks the recommendations button in order to obtain recommendations that are based upon the top three items in the search result.

Examiner interprets top three items in the search result, i.e., book items 411-413 as seed items because the user clicks a recommendations button in order to obtain recommendations that are based on the top three items in the search result. Furthermore, examiner interprets recommendations as “generated list” in claim 15.

Specification page 6, paragraph 5 includes:

Thus the recommended items shown in Figure 5 are a combination of the top items returned by the search and recommendations based upon the top items.

Rewriting above sentence with respect to the claim language:

Thus the recommended items (claimed generated list) shown in Figure 5 are a combination of the top items returned by the search (claimed seed items) and recommendations based upon these top items.

Examiner concludes. Specification page 6, paragraph 5, does not comply with the claim limitation “wherein the generated list does not contain the selected seed items” because the generated list is (emphasis added) a combination of seed items and recommendations based upon the seed items.

Consider Figure 5.

The recommendations of Figure 5 include items 510, 520, 530, 540, 550 and 560. Referring back to Figure 4, it can be seen that item 510 is seed item 411, item 520 is seed item 413 and item 540 is seed item 412. Figure 5 does not (emphasis added) comply with the claim limitation “wherein the generated list does not contain the selected seed items” because the generated list (interpreted as Recommendations) does (emphasis added) contain selected seed items, i.e., item 510/411, item 520/413 and item 540/412.

Consider Figure 6.

Figure 6, includes recommendations 610, 620, 630, 640 and 650. Referring back to Figure 4, it can be seen that item 620 is seed item 413 and item 650 is seed item 411. Clearly Figure 6 does not comply with the claimed limitation “wherein the generated list does not contain the selected seed items.”

Consider Figure 7.

Figure 7 includes recommendations 710, 720, 730, 740, and 750. Referring back to Figure 4, it can be seen that item 710 is seed item 413, item 740 is seed item 411 and item 750 is seed item 412. Clearly, Figure 7 does not comply with the limitation “wherein the generated list does not contain the selected seed items.”

Furthermore, analyzing Figures 4-7 on a per book basis, it can be seen that the below books appear in more than one Figure and in multiple characterizations, i.e., seed item and recommended item.

The Complete Idiot's Guide to Digital Photography, by Steve Greenberg, Paperback

- (1) Seed Item 411 per Figure 4.
- (2) Recommended item 510, Figure 5
- (3) Recommended item 650, Figure 6
- (4) Recommended item 740, Figure 7

Digital Camera Solutions, Gregory Georges, Paperback

- (1) Seed Item 412, Figure 4
- (2) Recommended Item 540, Figure 5
- (3) Recommended item 750, Figure 7

Real World Digital Photography Industrial Strength Techniques, by Duke McClelland, Katrin Eismann, Paperback

- (1) Seed Item 413, Figure 4
- (2) Recommended item 520, Figure 5
- (3) Recommended item 620, Figure 6
- (4) Recommended item 710, Figure 7.

Clearly, the written description included in the specification contradicts (emphasis added) “generating a list of recommended items each based on the selected seed items, wherein the generated list does not contain the selected seed items” because three books are characterized as a seed item and a plurality of recommended items. One of ordinary skill in the art would be frustrated and confused by the present invention because seed items reappear as recommended items. In fact seed items 411 and 413 reappear as recommended items in four instances.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Etienne P LeRoux/

Primary Examiner, Art Unit 2161

Conferees:

/Apu M Mofiz/

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/John Breene/

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